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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,311

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EXAMINER

JONES, HEATHER RAE

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,311	Applicant(s) OHIZUMI ET AL.	
	Examiner HEATHER JONES	Art Unit 2481	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 37,38,41,42,44,45 and 47-49 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 37,38,41,42,44,45 and 47-49 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 31 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/11/2011, 8/16/2011</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 26, 2011 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 37, 38, 41, 42, 44, 45, and 47-49 have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant's arguments filed May 26, 2011 have been fully considered but they are not persuasive.

The Applicant argues on page 11, lines 13-15 that "Uchikoga does not describe a configuration that is capable of executing contents of an external recording medium and a recording unit in a common processing unit." In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "executing contents of an external recording medium and a recording unit in a common processing unit") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant argues on page 11, lines 19-21 that "Uchikoga does not anywhere describe a process or methodology where the content being executed is controlled by a processing unit so as to thereby limit if not block the content's ability to access other local resources." The Examiner agrees because Uchikoga was not relied upon to disclose this concept. Furthermore, Cheng discloses in col. 3, lines 7-16 that the subscription information includes parameters controlling the execution of specified functions of an application and parameters controlling access by the application to local resources. Meanwhile the ASP controls access to local resources while the application is running based on the subscription. Therefore, Cheng meets the claimed limitations and the rejection is maintained.

The Applicant argues on page 13, lines 4-6 that the primary and secondary references involve different application environments, local execution of an application and remote execution of an application. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 37, 38, 41, 42, 44, 45, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchikoga (U.S. Patent Application Publication 2001/0005446) in view of Cheng (U.S. Patent 7,096,491) in view of Hori et al. (U.S. Patent Application Publication 2002/0131594).

Regarding claim **37**, Uchikoga discloses a recording and reproducing apparatus (see [0091]: "...reference numeral 100 denotes a stream data playback apparatus..."; [0094]: "The distributed stream data is received by and stored in the stream playback apparatus 100."; see also figures 2 and 7, particularly items 1 and 100, respectively) comprising: an external interface to connect with an external recording medium having a content recorded thereon (see [0102]: "...communication interface (102) for communicating with the server (300) through the network (200)..."); a recording unit that records the content read from the external recording medium connected to the external interface; a processing unit that reproduces or executes the recorded content in the external recording medium or the recording unit; wherein the processing unit has an installation processing unit that installs the content recorded in the external recording

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medium together with specified management information into a certain area of the recording unit (see [0102] - [0105]: "...the control unit 101 of the stream data playback apparatus 100...acquires video, audio, and control data distributed from the server 300 (step s12) and stores them in a disk serving as the storage device 105..." wherein the control data reads on "management information"); wherein the processing unit instructs the installation processing unit to install based on an installation instruction from the content that is reproduced or executed by the processing unit; wherein the installation process to the certain area of the recording unit cannot be executed by other than the installation processing unit (see [0046] - [0048]: "The authentication unit 42 performs mutual authentication with the external server 90... If mutual authentication is not normally done in the authentication unit 42, no program is loaded."; see the entirety of [0092]; see [0105]: "...the control unit 101 of the playback apparatus 100 reads out the control data stored in the disk, and performs playback processing of the video and audio data in the disk in accordance with the control data."; see also figures 10-11 which detail playback processes A through D, particularly steps s12 and s13 which show control data being saved to disk); wherein the recording unit records and has a management information file of the specified management information (see [0102] - [0105]: "...the control unit 101 of the stream data playback apparatus 100...acquires video, audio, and control data distributed from the server 300 (step s12) and stores them in a disk serving as the storage device 105..." wherein the control data reads on the "management information");

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wherein the management information includes a conversion table for processing both the content installed in the certain area of the recording unit and the content recorded on the external recording medium (see [0113] - [0114]: "If the playback apparatus 100 determines that the stream data can be played back...it executes the playback processes A to D of playing back video and audio data in the memory buffer in accordance with control data in the memory buffer...The playback apparatus 100 performs multitask processing of receiving stream data from the server 300 and storing them in the memory buffer" wherein the control data reads on the "conversion table"); a loading unit that reads contents recorded in the recording unit and the external recording medium based on the conversion table; wherein the processing unit is able to load the content only through the loading unit (see [0116]: "Then, the server 300 distributes the control data to the playback apparatus 100, and the playback apparatus 100 receives the control data and stores it in the memory buffer or disk...The playback apparatus 100 reads out the stored control data, and executes the playback processes A to D of playing back video and audio data in accordance with the control data (step s66)."); and, wherein the processing unit is configured so as to add access constraints to the recorded content that can be reproduced or executed by the recording and reproducing apparatus (see [0092]: "Control data has functions of limiting playback contents, e.g., a user operation limitation function, playback channel limitation function.... playback stream data limitations function, and a function of checking user operation and playing back a stream."). However,

Uchikoga fails to disclose wherein the processing unit is configured so as to automatically add access constraints to the recorded content, the access constraints being automatically established for controlling access by the content during said reproducing or executing to local resources of the recording and reproducing apparatus based on the process of the content.

Referring to the Cheng reference, Cheng discloses mobile code security architecture in an application service provider environment (see title). Furthermore, Cheng discloses the access constraints being established for controlling access by the content during said reproducing or executing to local resources of the recording and reading apparatus based on the process of the content (see column 2, line 41 through column 3, line 16 with particular emphasis on column 3, lines 7-16: "...the subscription information includes parameters controlling the execution of specified functions of an application and parameters controlling access by the application to local resources...While the application is running, the ASP controls access to local resources based also on the subscription information."; column 5, lines 14-28: "...the security application 234 may containing application program interface (API) access conditions and a resource access privilege request...The resource access privilege request is any request that specifies the type of local resource 218 access that is needed for the application 232 to complete certain tasks."; column 8, lines 12-16: "If the user 220 has given permission, then the application 232 is run 146 according to the

parameters of the user's subscription, and the security manager 216 controls access by the application 232 to local resources 218.").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Uchikoga to include the teachings of Cheng, for the purpose of protecting an end user from malicious code downloaded from an external source. However, Uchikoga in view of Cheng still fails to disclose wherein the processing unit is configured so as to automatically add access constraints to the recorded content and the access constraints being automatically established.

Referring to the Hori et al. reference, Hori et al. discloses a recording and reproducing apparatus that comprises a processing unit that is configured so as to automatically add access constraints to the recorded content that can be reproduced or executed by the recording and reproducing apparatus, the access constraints being automatically established for controlling access (paragraph [0218] – during the check-out process of the video content the access constraints are automatically recorded with the content and the constraints are already automatically established for controlling access to the content).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automatically added and establish access constraints to the recorded content as disclosed by Hori et al. in the apparatus disclosed by Uchikoga in view of Cheng in order to ensure the recorded contents are not illegally copied as well as tampered with.

Regarding claim **38**, this is a method claim corresponding to the apparatus claim 37. Therefore, claim 38 is analyzed and rejected as previously discussed with respect to claim 37. Furthermore, the apparatus disclosed in claim 37 performs the method disclosed in claim 38.

Regarding claim **41**, this is a medium claim corresponding to the apparatus claim 37. Therefore, claim 41 is analyzed and rejected as previously discussed with respect to claim 37. Furthermore, Uchikoga discloses a computer readable storage medium on which is stored a content, which content is for use with or execution on a computer, wherein the content is configured and arranged so as to include the installation instruction to be supplied to the recording and reproducing apparatus of claim 37 (see [0102]: "...a storage device 105 such as a disk for storing distributed video and audio data..."; [0105]: "...control data...stores them in...storage device 105...the playback apparatus 100 reads out the control data stored in the disk, and performs playback processing of the video and audio data in the disk in accordance with the control data."), whereby a processing unit of the recording and reproducing apparatus instructs an installation processing unit to install based on an installation instruction from the content that is reproduced or executed by the processing unit (see [0046] - [0048]: "The authentication unit 42 performs mutual authentication with the external server 90... If mutual authentication is not normally done in the authentication unit 42, no program is loaded."; see the entirety of [0092]; see [0105]: "...the control unit 101 of the playback apparatus 100 reads out the

control data stored in the disk, and performs playback processing of the video and audio data in the disk in accordance with the control data."; see also figures 10-11 which detail playback processes A through D, particularly steps s12 and s13 which show control data being saved to disk).

Regarding claim **42**, the combination of Uchikoga and Cheng in view of Hori et al. discloses everything claimed as applied above (see claim 38). Further, Uchikoga discloses a computer on which is stored a computer program for execution on the computer, the computer program being configured and arranged so as to cause the computer to execute the file accessing method of claim 38 (see [0036] - [0037]: "The present invention can be implemented by a computer...Note that the multimedia information playback apparatus 1 may be constituted by replacing the decoder 16 as a device with a program for decoding data read out from the HDD 18 to the RAM 12").

Regarding claim **44**, Uchikoga in view of Cheng in view of Hori et al. disclose all the limitations as previously discussed with respect to claim 38, including that the processing unit adds access constraints during said installing (Uchikoga: paragraph [0092]: "Control data has functions of limiting playback contents, e.g., a user operation limitation function, playback channel limitation function....playback stream data limitations function, and a function of checking user operation and playing back a stream.").

Regarding claim **45**, Uchikoga in view of Cheng in view of Hori et al. disclose all the limitations as previously discussed with respect to claim 38,

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including that when the recording and reproducing apparatus reproduces or executes any content, the processing unit prohibits the reproduced or executed content from accessing the recording unit, the external recording medium, a server operably coupled to the recording and reproducing apparatus or a memory operably coupled to the processing unit (Cheng: wherein the "local resources 218" reads on the claimed, "...a memory operable coupled to the processing unit").

The prior motivation as discussed above is applied herein.

Regarding claim **47**, this is a method claim corresponding to the apparatus claim 45. Therefore, claim 47 is analyzed and rejected as previously discussed with respect to claim 45. Furthermore, the apparatus disclosed in claim 45 performs the method disclosed in claim 47.

Regarding claim **48**, Uchikoga in view of Cheng in view of Hori et al. disclose all the limitations as previously discussed with respect to claim 37, including that the access constraints are automatically added to the recorded content during installation, when content is being downloaded to the recording unit (Hori et al.: paragraph [0218] – during the check-out process of the video content the access constraints are automatically recorded with the content and the constraints are already automatically established for controlling access to the content).

The prior motivation as discussed above is applied herein.

Regarding claim **49**, this is a method claim corresponding to the apparatus claim 48. Therefore, claim 49 is analyzed and rejected as previously discussed with respect to claim 48. Furthermore, the apparatus disclosed in claim 49 performs the method disclosed in claim 48.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEATHER JONES whose telephone number is (571)272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Heather R Jones
Examiner
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December 19, 2011